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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,271	10/20/2000	Donald C. Mann	ULT-001-1	7503

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EXAMINER	
WALSH, DANIEL I	
ART UNIT	PAPER NUMBER
2876	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/693,271	MANN ET AL.	
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-10,16,17,19,21-30,38 and 47-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-10,16,17,19,21-30,38 and 47-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 5-21-07.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4, 10, and 28, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differences are obvious to one of ordinary skill in the art.

Claim 1 of the current application recites: "A portable card...data storage device...moved relative to each other.... substrate...high density...hard, abradeable protective coating...ambient natural atmosphere...magnetically permeable, magnetically saturable material." (re claim 1),

claim 10 recites "A portable card...data storage device...moved relative to each other....substrate...high density...hard, abradeable protective coating...ambient natural atmosphere...magnetically permeable, magnetically saturable material." (re claim 1), wherein claim 1 of the '739 Patent recites: "A portable card... data storage device...moved relative to each other....substrate...high density...hard, abradeable protective coating...ambient natural atmosphere...magnetically permeable, magnetically saturable material." (re claim 1). Though the '739 Patent fails to teach the substrate is rectangular and the magnetic track is arcuate, the Examiner notes that rectangular cards are well known and conventional in the art for convenience and usability, and that arcuate tracks are also well known as a matter of design variation, system constraints, or for security, and therefore are obvious expedients. Re claim 10, though silent to movement, the Examiner notes that it is conventional in the art to swipe magnetic cards to effect reading for ease of use.

3. Claims 5-9 and 16-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Liu et al. (US 2001/00525433)

The teachings of the '739 Patent have been discussed above.

Re claims 5-9, the '739 Patent is silent to magnetic signals being stored in arcuate shaped tracks.

Liu et al. teaches such limitations (FIG. 2D-2Q).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Liu et al.

One would have been motivated to do this to have increased data storage tracks, storage, based on system constraints, etc.

Re claim 5, the tracks extend between the sides as shown in the figures.

Re claims 6-9, as the arcuate/circular tracks are enclosed by the 4 sides of the card, they are interpreted as extending/located/centrally between the longer and shorter sides.

Re claims 16-17, the limitations have been discussed above.

4. Claims 21 and 22-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Chedister (US 6,310,471).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to a relatively hard, abradeable protective coating formed on the magnetic material layer.

Chedister teaches such limitations (coating 128).

At the time the invention was made, it would have been obvious to combine the teachings of the '739 Patent with those of Chedister in order to have a means to protect against wear.

Though silent to being cleanable, it is obvious that the card can be wiped/cleaned for removal of particles of dirt, for example.

Re claim 23, as the protective coating is applied to the card, it is interpreted as applied on one of the surfaces.

Re claim 24, the limitations have been discussed above.

5. Claims 19, 26, 47, and 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Bajorek (US 6,482,330).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to a thin film magnetic layer and bonded lubricant layer having a thickness less then the protective coating.

Thin film layers are conventional in the art for increasing density, size constraints, protection, etc. Nonetheless, Bajorek teaches a thin film layer (col 1, lines 25+) and that a lubricant can be applied to the protective overcoat (col 4, liens 52+).

Though silent to the thickness, it would have been obvious to one of ordinary skill in the art to have the lubricant thinner than the protective layer as the lubricant is just employed to provide lubrication such as wiping it onto the protective layer, as a finishing step would be very thing. Further, the selection of an optimum value/range to effect a desired result is well within the skill in the art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Bajorek.

One would have been motivated to do this to provide expected results within minimum thickness added.

Re claim 47, Bajorek teaches sputter (abstract) for a thin layer with desirable properties.

Re claim 49, Bajorek teaches an oxide for the magnetic material (col 1, lines 15+ for storage ease).

6. Claims 24, 27, and 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Wood et al. (US 5,041,9220).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to the movement between the card and processing station.

Wood teaches such limitations (claim 16) and a protecting layer 14.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Wood et al. to effect movement for processing the card and quality of signals transferred.

7. Claim 25 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Changnon (US 3,732,640).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to protective coatings on both card sides.

Changnon teaches such limitations (claim 11).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Changnon.

One would have been motivated to do this for extra protection.

8. Claim 28 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Rose (US re38,290).

The teachings of the '739 Patent been discussed above.

The '739 Patent is silent to the card moving relative to the processing station.

Rose teaches such limitations (col 2, lines 22+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Rose.

One would have been motivated to do this in order to speedily process the card. The Examiner notes that both moving the card/moving the reader are well known in the art to process card information.

9. Claim 29 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view of Mizoguchi et al. (US 5,689,105).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to the processing station moving relative to the card/substrate. Mizoguchi et al. teaches such limitations (abstract).

At the time the invention was made, it would ha been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Mizoguchi et al.

One would have been motivated to do this to accurately process the card (process with conformity).

10. Claim 38 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view Nishiyama et al. (US 5,721,942).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to the claim density range.

Nishiyama teaches a card with the claimed range (see claim 4).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Nishiyama et al.

One would have been motivated to do this for increased storage capacity.

11. Claim 48 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view Meeks (US 6,268,919).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to the plating.

Meeks teaches such limitations (col 1, lines 43-50).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Meeks for desirable magnetic properties.

12. Claim 50 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,036,739 in view Foley et al. (US 4,518,627).

The teachings of the '739 Patent have been discussed above.

The '739 Patent is silent to the web coating.

Foley et al. teaches such limitations (col 3, lines 15-35, abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of the '739 Patent with those of Foley et al.

One would have been motivated to do this for a durable magnetic medium.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel I Walsh
Examiner
Art Unit 2876

DANIEL WALSH
PRIMARY EXAMINER